

## **REMARKS**

### **CLAIM OBJECTIONS**

Claims 37 and 40 were objected to because of informalities and have been appropriately amended.

### **REJECTIONS UNDER 35 U.S.C. § 112**

Claims 8, 24 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter.

Applicant has amended claims 8, 24 and 40 to cure any deficiencies in clarity. Applicant submits claims 8, 24 and 40 are definite as amended.

### **REJECTIONS UNDER 35 U.S.C. § 103**

#### **Claims 1, 5, 9, 17, 21, 33 and 37**

Claims 1, 5, 9, 17, 21, 33 and 37 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,009,173 issued to Sumner (*Sumner*) and in view of U.S. Patent No. 6,189,098 issued to Kaliski, Jr. (*Kaliski*) and in view of U.S. Patent No. 5,355,416 issued to Ohno (*Ohno*). Applicant submits claims 1, 5, 9 17, 21, 33 and 37 are not obvious for at least the reasons set forth below.

Claim 1 recites, in part, pre-calculating a plurality of authenticator messages based on a corresponding plurality of estimated time parameters, wherein each authenticator message comprises at least part of the shared secret and selecting a pre-calculated authenticator message that corresponds to an actual time parameter. Claims 17 and 33 recite similar limitations. The Office action correctly concedes that *Sumner* and *Kaliski* fail to disclose the limitations referenced above. The Office action cites *Ohno* as disclosing the deficient limitations – specifically citing Figs. 3 and 4, col. 4, lines 55-64 and col. 6 lines 27-37. In *Ohno*, an authentication code is selected on the basis of a

stored time table (see col. 6, lines 30-33). In contrast, the authenticator messages of claim 1 are pre-calculated based on a corresponding plurality of estimated time parameters. In other words, in *Ohno*, a time table is used to select an authenticator code, while in claim 1, time parameters are used to pre-calculate the authenticator messages. Furthermore, the time parameters in claim 1 are estimated while the time table in *Ohno* is based on counters (see col. 6, lines 30-33 and Fig. 4), not estimation.

Also, *Ohno* is silent with respect to the content of the authentication codes. Col. 4, lines 55-64 mentions data corresponding to an authentication code, but fails to define or explain the data. Thus, *Ohno* does not provide explicit support for an authenticator message to include at least part of a shared secret, as recited in claim 1. Without explicit support, the Office action necessarily relies on inherency, discussed in more detail below.

The Manual of Patent Examining Procedure (MPEP) § 2131 states, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Per MPEP § 2112, “the inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.” *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995). MPEP § 2112 further states, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (emphasis added). Thus, in relying upon the theory of inherency, “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent

characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Additionally, MPEP § 2112 states, "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Given the discussion above, Applicant submits that the Office action fails to establish any inherency in *Ohno* with respect to the inclusion of at least part of a shared secret in an authenticator message, as claimed. The Office action provides no facts or technical reasoning to support such an assertion of inherency.

For at least the reasons set forth above, Applicant submits *Ohno* fails to cure the deficiencies of *Sumner* and *Kaliski* with respect to claims 1, 17 and 33. Therefore, Applicant submits claims 1, 17 and 33 are not obvious in view of *Sumner*, *Kaliski*, and *Ohno*. Applicant submits dependent claims 5, 9, 21 and 37, which necessarily include the limitations of their respective independent claims, are not obvious for at least the same reasons claims 1, 17 and 33 are not obvious.

Claims 2, 3, 18, 19, 34, and 35

Claims 2, 3, 18, 19, 34, and 35 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,009,173 issued to Sumner (*Sumner*) in view of U.S. Patent No. 6,189,098 issued to Kaliski, Jr. (*Kaliski*) and in view of U.S. Patent No.

5,355,416 issued to Ohno (*Ohno*) and in view of U.S. Patent No. 6,754,824 issued to Persson et al. (*Persson*). Dependent claims 2, 3, 18, 19, 34 and 35 depend from claims 1, 17 and 33, respectively. As discussed above, *Sumner*, *Kaliski*, and *Ohno* fail to render claims 1, 17 and 33 obvious. *Persson* does not cure the deficiencies of *Sumner*, *Kaliski*, and *Ohno*. Thus, Applicant submits claims 2, 3, 18, 19, 34 and 35 are not obvious for at least the same reasons claims 1, 17 and 33 are not obvious.

Claims 8, 24 and 40

Claims 8, 24 and 40 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,009,173 issued to Sumner (*Sumner*) in view of U.S. Patent No. 6,189,098 issued to Kaliski, Jr. (*Kaliski*) and in view of U.S. Patent No. 5,355,416 issued to Ohno (*Ohno*) and in view of U.S. Patent Publication No. 2004/0131014 issued to Thompson, III et al. (*Thompson*). Dependent claims 8, 24 and 40 depend from claims 1, 17 and 33, respectively. As discussed above, *Sumner*, *Kaliski*, and *Ohno* fail to render claims 1, 17 and 33 obvious. *Thompson* does not cure the deficiencies of *Sumner*, *Kaliski*, and *Ohno*. Thus, Applicant submits claims 8, 24 and 40 are not obvious for at least the same reasons claims 1, 17 and 33 are not obvious.

## **CONCLUSION**

For at least the foregoing reasons, Applicant submits that the rejections have been overcome. Therefore, claims 1-3, 5, 8-9, 17-19, 21, 24, 33-35, 37 and 40 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,  
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I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below.

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